



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,111	09/19/2001	Ichiro Oshima	MESIP045	4704
22434	7590	04/07/2005	EXAMINER	
BEYER WEAVER & THOMAS LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,111

Applicant(s)

OSHIMA, ICHIRO

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-25 have been examined.

Response to Amendment

2. The Amendment filed on 12/30/04 is insufficient to overcome the Robertson reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 8-10, 12, 13, 16-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Robertson (6,609,106).

Claim 1, 16, 17, 24: Robertson discloses a gift mediation system, method that implements gift mediation via a network through access to data storage means, which is provided on a server and stores predetermined data therein, said gift mediation system comprising:
first memory means that stores registry of information on a recipient, who is expected to receive gift, together with individual information used for authentication on the network (Fig. 12; Fig. 15; Fig. 16);

Art Unit: 3622

second memory means that stores a password used to authenticate a giver who desires to give the gift on the network (Fig. 15, item 260; Fig. 8; col 11, lines 54-58);

permission means that identifies the individual information in response to a requirement for access via the network and gives authorization to access said data storage means via the network when identity with at least part of the individual information registered in said first memory means is verified (Fig. 20B; Fig. 20C);

wish list registry means that registers a wish list including at least one item for the gift into said data storage means by the authorized access (Fig. 27, item 505); and

wish list reference means that allows the wish list to be referred to by access via the network using the password stored in said second memory means (Fig. 21, item 350; Fig. 28).

Robertson further discloses wish list registry means that specifies a wish list including at least one item for the gift, based on information regarding items other than the predetermined data stored in said data storage means, after the access authorized by said first permission means, and registers information on the specified wish list in said data storage means (Fig. 33; item 575, item 570).

Additionally, Robertson discloses utilizing a password for identifying and logging on users (Fig. 15 and below): “(7) Prior to using the Online Gift Registry Service, users and Service Providers, must register with the Online Registrar. This involves the following steps.

1. The user registers with the Gift Registrar by providing user information (name, address, phone number, etc.) and notice trigger events (holidays, special events, etc.) to the Registrar. The user additionally agrees to a contract, and establishes a personal password that is known only by the user and the Registrar” (col 9, lines 51-61).

Art Unit: 3622

Robertson discloses multiple memory means for storing user related information:

“(22) The Gift Registry site 70 includes one or more physical databases for storing various account information with respect to the users and Service providers. This information preferably includes the passwords and profiles” (col 12, lines 57-62).

Robertson discloses that gift purchasers can be registered users or that registered users can be gift purchasers:

“(13) Additionally, it may be assumed that the term "registrant" and the term "Service Provider" refers only to registered users and Service Providers respectively. The term "gift purchasers" may refer to registered users or non-registered users” (col 11, lines 50-57).

Therefore, any of the information that applies to registered users (such as passwords) can also apply to gift purchasers or gift givers.

Additionally, Fig. 32 and Fig. 33 and Fig. 14 (item 15, item 30, item 32, item 33) disclose that the gift giver can access a wish list of a gift receiver.

Claim 2: Robertson discloses a gift mediation system in accordance with claim 1, and further discloses that said first memory means comprises means that stores registry of information on at least two recipients together with individual information on a single individual (col 1, lines 55-60; Fig 27;).

Claim 3: Robertson discloses a gift mediation system in accordance with claim 1, and further discloses that said first memory means comprises:
event registry means that registers a type of event for the gift (Fig. 40); and
means that stores registry of information on a plurality of recipients together with individual information on a single individual when the type of event registered in said event registry means

Art Unit: 3622

coincides with a preset event involving the plurality of recipients, such as engagement or wedding (Fig. 27; Fig. 40).

Claim 4: Robertson discloses a gift mediation system in accordance with claim 1, and further discloses that said gift mediation system further comprises:
address registry means that registers an address of the giver who desires to give the gift (Fig. 16; col 11, lines 54-58); and notification means that notifies the address registered by said address registry means of the password and information on a procedure of gaining access to said data storage means, on completion of the registry by said wish list registry means (Fig. 20C, item 330).

Claim 5: Robertson discloses a gift mediation system in accordance with claim 1, and further discloses that said wish list registry means comprises:
item information storage means that individually stores information on a plurality of items;
item selection means that causes at least one item to be selected among the plurality of items stored in said item information storage means; and
enumerative display means that displays the wish list of the at least one item selected by said item selection means in an enumerative manner (Fig. 33; Fig. 28).

Claim 6: Robertson discloses a gift mediation system in accordance with claim 5, and further discloses that said item information storage means comprises means that stores information on each item with its category in said item information storage means and displays the stored information on the plurality of items classified by the category for selection of the at least one item by said item selection means (Fig. 28).

Art Unit: 3622

Claim 8: Robertson discloses a gift mediation system in accordance with claim 1, and further discloses that said wish list registry means comprises:

item information acquisition means that obtains information on items from another data storage means, which is present on the network, together with information for identifying said another data storage means; and

enumerative display means that extracts at least information on a price of each item and the information for identifying said another data storage means among the information on the items obtained by said item information acquisition means, and displays the extracted information in an enumerative manner (Fig. 24; Fig. 41, item 570, 575; Fig. 33; Fig. 34).

Claim 9, 26: Robertson discloses a gift mediation system in accordance with claim 5, 8, and further discloses that said enumerative display means comprises means that displays a 'Delete' button to instruct deletion of a specified item from the registered wish list (Fig. 27, item 515).

Claim 10: Robertson discloses a gift mediation system in accordance with claims 1, and further discloses that said gift mediation system further comprises:

display means that displays the wish list of the at least one item registered by said wish list registry means in an enumerative manner, in response to access using the password;

application means that individually accepts an offer of payment for each item included in the displayed wish list; and

offer record display means that displays an offer record of the item for which the payment has been offered (Fig. 33; Fig. 36; Fig. 37).

Art Unit: 3622

Claim 12: Robertson discloses a gift mediation system in accordance with claim 10, and further discloses that said gift mediation system further comprises:

payment demand means that requires a giver who has offered the payment to actually pay for the item for which the payment has been offered (Fig. 36).

Claim 13: Robertson discloses a gift mediation system in accordance with claim 10, and further discloses that said gift mediation system further comprises:

detailed information display means that displays the wish list of the at least one item registered by said wish list registry means in an enumerative manner, as well as information for authenticating the giver who has offered the payment with regard to the item for which the payment has been offered, in response to the access via the network authorized by said permission means (Fig. 33; Fig. 36).

Claim 18, 25: Robertson discloses a gift mediation system, medium in accordance with claim 17. Robertson further discloses that said gift mediation system further comprises: second permission means that gives authorization to access another data storage means, which is connected to said data storage means via the network, after the authorized access to said data storage means; and item information acquisition means that obtains information on items stored in said another data storage means, different from said data storage means, in response to a specified instruction, wherein said wish list registry means specifies the wish list of the at least one item for the gift, based on the information obtained by said item information acquisition means, and registers the information on the specified wish list in said data storage means (Fig. 33; Fig. 34; col 3, lines 60-65).

Claim 19: Robertson discloses a gift mediation system in accordance with claim 18, and further discloses that said item information acquisition means obtains information on description of respective items, such as product names and product numbers of the items, as well as information on an address, at which the information on the items is stored in said another data storage means (Fig. 33, item 560).

Claim 20: Robertson discloses a gift mediation system in accordance with claim 17, and further discloses that said data storage means stores in advance information on items as the predetermined data, said item information acquisition means obtains both the information on the items stored in advance in said data storage means (col 2, lines 55-61; Fig. 1) and the information on the items stored in said another data storage means (col 2, lines 25-30; Fig. 1), and said wish list registry means registers both the information obtained by said item information acquisition means on a common list in said data storage means (Fig. 1; Fig. 28; Fig. 33).

Claim 21: Robertson discloses a gift mediation system in accordance with claim 20, and further discloses that said gift mediation system further comprising: display means that displays the information registered on the common list in said data storage means in an enumerative manner (Fig. 28; Fig. 33).

Claim 22: Robertson discloses a gift mediation system in accordance with claim 18, and further discloses that said gift mediation system further comprises: settlement means that settles an account of each item included in the wish list, whose information is registered by said wish list registry means, between said server managing said data storage

Art Unit: 3622

means and another server managing said another data storage means via the network (col 25, lines 10-15; col 15, lines 30-43).

Claim 23: Robertson discloses a gift mediation system in accordance with claim 17, and further discloses that a terminal that gains access to said data storage means via the network is installed at a shop of a retailer who sells items, and said wish list registry means specifies the wish list of the at least one item for the gift, based on information on items checked at the shop by the recipient who is expected to receive the gift, after access authorized by said terminal, and registers information on the specified wish list in said data storage means (col 25, lines 15-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (6,609,106) in view of Call (6,154,738).

Claim 7: Robertson discloses a gift mediation system in accordance with claim 5. Robertson further discloses that said item information storage means stores at least information on a price of each item and a photographic image representing appearance of each item, and

said enumerative display means displays the photographic image of the appearance of each item (Fig. 28; Fig. 38).

Robertson further discloses expanding information and that the user can access more information on an item (col 22, lines 47-57).

Robertson does not explicitly disclose that the image can be magnified.

However, Call discloses that product images can be magnified (Fig. 33; col 23, lines 34-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Call's product image magnification to Robertson's product image. One would have been motivated to do this in order to allow the user to see more detail on the item.

5. Claim 11, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (6,609,106) in view of Loeb (6,006,205).

Claim 11: Robertson discloses a gift mediation system in accordance with claim 10. Robertson further discloses that said application means comprises payment application means that allows payment for a specific item displayed by said display means to be offered by the access using the password,

said gift mediation system further comprising: total pay offer display means that displays a total of pay offer for the specific item (Fig. 36, Fig. 37), and the utilization of credit cards (Fig. 36).

Robertson does not explicitly disclose partial payment for a product or item.

Art Unit: 3622

However, Loeb discloses partial payment for a product or item (col 7, line 50-col 8, line 4) and the utilization of credit cards (Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Loeb's partial payment of an item to Robertson's payment for items utilizing a credit card. One would have been motivated to do this in order to allow purchases of items that are expensive and can be difficult for a user to pay for at one time.

Claim 14: Robertson discloses a gift mediation system in accordance with claim 10.

Robertson further discloses making purchases and the utilization of credit cards (Fig. 36, Fig. 37).

Robertson further discloses an event notification for a wide variety of events (col 3, lines 47-50).

Robertson does not explicitly disclose due time memory means that stores a due time of access to said data storage means;

due time detection means that detects elapse of the due time; and

notification means that notifies a registrant who has registered the wish list of information on the item for which the payment has been offered, in response to the detection of the elapse of the due time.

However, Loeb discloses due time memory means that stores a due time of access to said data storage means;

due time detection means that detects elapse of the due time; and

Art Unit: 3622

notification means that notifies a registrant who has registered the wish list of information on the item for which the payment has been offered, in response to the detection of the elapse of the due time (col 6, lines 30-44; Fig. 3; col 10, lines 9-20; Fig. 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Loeb's tracking of payments and time to Robertson's credit card payment and event notification. One would have been motivated to do this in order to allow Robertson to better ensure that payments for items are made.

Claim 15: Robertson and Loeb disclose a gift mediation system in accordance with claim 14. Robertson further discloses that said first memory means comprises means that stores registry of an address for delivery of the item for which the payment has been offered and a postal address of the recipient who is expected to receive the gift, as the information on the recipient (Fig. 36; Fig. 16; Fig. 17).

Response to Arguments

6. Applicant's arguments with respect to claims 1-25 have been considered but are not found persuasive.

On page 10 of the Applicant's Amendment dated 12/30/04, Applicant states that Robertson does not disclose a second memory means that a password user to authenticate a giver who desires to give the gift on a network. Particularly, Applicant states that Robertson does not disclose a password for a gift giver.

However, Robertson discloses utilizing a password for identifying and logging on users (Fig. 15 and below):

Art Unit: 3622

“(7) Prior to using the Online Gift Registry Service, users and Service Providers, must register with the Online Registrar. This involves the following steps. 1. The user registers with the Gift Registrar by providing user information (name, address, phone number, etc.) and notice trigger events (holidays, special events, etc.) to the Registrar. The user additionally agrees to a contract, and establishes a personal password that is known only by the user and the Registrar” (col 9, lines 51-61).

Robertson discloses multiple memory means for storing user related information:

“(22) The Gift Registry site 70 includes one or more physical databases for storing various account information with respect to the users and Service providers. This information preferably includes the passwords and profiles” (col 12, lines 57-62).

Robertson discloses that gift purchasers can be registered users or that registered users can be gift purchasers:

“(13) Additionally, it may be assumed that the term "registrant" and the term "Service Provider" refers only to registered users and Service Providers respectively. The term "gift purchasers" may refer to registered users or non-registered users” (col 11, lines 50-57).

Therefore, any of the information that applies to registered users (such as passwords) can also apply to gift purchasers or gift givers.

Additionally, Fig. 32 and Fig. 33 and Fig. 14 (item 15, item 30, item 32, item 33) disclose that the gift giver can access a wish list of a gift receiver.

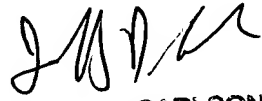
Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


JEFFREY D. CARLSON
PRIMARY EXAMINER

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

Arthur Duran
Patent Examiner
3/29/05